

Attorney Docket No. 9400-55
Application Serial No. 10/691,207
Filed: October 22, 2003
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REMARKS

In response to the Office Action dated March 1, 2005 ("the Action"), Applicant respectfully requests reconsideration based on the above claim amendments and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claims 1-33 are pending in the application but stand rejected as being obvious over U.S. Patent No. 5,663,711 to Sanders et al. ("Sanders"), alone or in view of U.S. Patent No. 6,229,450 to Malmsten ("Malmsten") and other secondary references. Applicant respectfully disagrees and will address these rejections below.

I. Claim Objections

The Action objects to Claims 1-2, 16-19 and 31 because of certain alleged informalities. Claim 1 recites "and/or", Claim 2 recites "on/in", and Claims 16-19 and 31 include the term "about" which is stated to not be allowed as "the dimension need to be exacted." Applicant respectfully disagrees but has amended Claim 2 to obviate the objection to that claim.

However, Applicant strongly disagrees with the use of "about" in the claims, as this term is a well-accepted term in United States patents. Indeed, the Sanders patent referenced by the Action employs this term in many of the issued claims.

In further support, Applicant invites the Examiner to carry out an electronic search of the USPTO database on issued patents using the search term "about" in the "claims". Applicant performed such a search and received 738,979 "hits."

Applicant also respectfully disagrees that the use of "and/or" makes the affected claims unclear. One of skill in the art would understand that the term "and/or" includes any and all combinations of one or more of the associated listed items. In support of the accepted use of this term, Applicant also invites the Examiner to carry out an electronic search summary of the issued U.S. patent database for the search term "and/or" in the claims. Applicant performed such a search and 112,825 patents were identified as using this terminology.

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In view of the foregoing, Applicant submits that the claims are in appropriate format and request that this objection be withdrawn.

II. The Art Rejections

Applicant submits that the claims are patentable over the cited prior art. The Action states that claims are obvious over Sanders alone, or in combination with other secondary and/or tertiary references.

Generally stated, the present invention is directed to light-weight, low-cost power failure alert devices that can promote increased consumer usage and can be used on GFI circuits. The devices are compact devices that employ a single plug in a standard wall socket and are sized so as not to cover both plug-ins of the standard dual plug-in socket. In some embodiments, the low cost, easy to use power failure alert devices can be disposed of after a single power disruption event.

A. Claims 12, 13, 29 and new Claims 34-36 are patentable over the cited art

The Action concedes that Sanders fails to teach that the audible alarm transmits a pre-recorded message. However, the Action states that U.S. Patent No. 5,463,595 to Rodhall et al. ("Rodhall") teaches a portable security system 10 with electronic memory in the form of a voice synthesizer 80 having at least one prerecorded message that is output when motion is sensed (Action, p. 6).

Rodhall proposes a rather heavy, large and complex device for "outdoor sites" and includes a high decibel siren, a strobe light 19 and speaker 78 for transmitting a pre-recorded message (Abstract). Applicant submits that there is no motivation to combine Rodhall with Sanders absent the teachings of the instant invention. Sanders is a plug-in power alarm device used for indoor wired circuits. Rodhall is a complex portable (heavy) security system for outdoor sites. It is legally improper to selectively combine references based on the fact that the references describe discrete components without considering the teachings of the references as a whole. One of skill in the art would not look to outdoor security systems for components to use in indoor plug-in power alert devices. Further, Rodhall was filed in 1993,

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Sanders was filed in 1995. Clearly, pre-recorded messages were known when Sanders was filed. However, Sanders is noticeably silent on the use of pre-recorded messages as the audible alert. Applicant submits that the Action improperly combines the references based on the teachings of the instant application. In addition, simplicity alone is not determinative of patentability. Applicant submits that Claims 12, 13 and 29 are patentable over the cited prior art.

Further, Applicant submits that new Claims 34-36, which recite that there are a plurality of different pre-recorded messages, are supported by the specification (*see*, p. 9) and are patentable over the cited art. Applicants have amended method Claim 22 to recite that the method includes selecting one of a plurality of pre-recorded messages and transmitting the selected message. Applicant submits that Claim 22 is patentable over the cited art.

B. Claims 21, 34 and new Claim 37 are patentable over the cited art

The Action concedes that Sanders fails to teach that the device is a single-use device that is disposable after a power disruption (p.8, Action). However, the Action then goes on to allege that it would have been obvious "to dispose of the device after power disruption occurs for the purpose of preventing failure detecting situation."

Although Applicant is unsure of the meaning of this statement, Applicant disagrees with the Action's assertion. Indeed, Sanders teaches away from a single-use disposable device because it includes a power reset switch 50 connected into the alert circuit that is reset by a reset button 52 projecting from the front of the housing (col. 2, lines 38-41). Applicant has canceled Claim 21 and incorporated the subject matter into Claim 1 above. Accordingly, Applicant submits that Claim 1 is in condition for allowance for at least the reasons discussed above.

Further, Applicant has added new dependent Claim 37 above, which states that a component in the electronic circuit is impaired or destroyed after a power disruption (as described at p.7 of the pending application) thus inhibiting reuse. Claim 32 has been similarly amended. Applicant submits that Sanders clearly fails to teach or suggest such a feature and that Claim 32 and new Claim 37 are patentable over the cited references.

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C. Claim 15 and new Claims 38-40 are patentable over the cited art

The Action states that as Sanders proposes a visual alert device, it would have allegedly been obvious to one of skill in the art to "design the visual alert deviceto visually indicate to delay generating of the audible alert when power disruption occurs instead of providing indication of the presence of power for the purpose of alerting user the condition of power disruption" (Action, p. 7). Although Applicant is unsure of the meaning of this statement, Applicant disagrees with the Action's assertion.

Claim 15 recites that the visual alert device comprises a light emitting diode, and wherein the device is configured to delay generating the audible alert until power is disrupted for greater than a predetermined time. Applicant does not claim that the device visually indicates the presence of power disruption, rather only that the device includes a visual alert with an LED. However, Sanders fails to teach or suggest delaying the audible alert for greater than a predetermined time.

As described at p. 6 of the pending application, the alert signal 10s as well as the timer may be configured to operate with a predetermined delay so that minor power disruptions, typically lasting less than about 5-10 minutes or other desired interval, do not trigger the alert(s) and/or the elapsed timer. New Claim 38 recites that the audible alert is not generated until the outage extends beyond at least about 5 minutes.

In some embodiments, also described at p.6, the display 25 and/or timer may be manually reset, such as with a manual externally accessible reset switch (not shown). The device 10 may include memory for storing different power outage durations occurring over a desired interval. The device 10 can include a user input button that allows a user to prompt the device 10 for the outage duration/length of each detected outage event. The visual alert 15 may be configured to present a different visual appearance when more than one event is detected and not cleared from the device's electronic memory. Applicant has added new Claims 39 and 40 directed to this embodiment. Applicant submits that these claims are patentable over the cited prior art references.

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D. Claims 16-19 and 31 are patentable over the cited prior art

The Action concedes that Sanders does not disclose the claimed size configurations but goes on to state that the claimed configurations are an obvious design choice and that size is generally recognized as being within the level of ordinary skill (Action, p. 7). Applicant respectfully disagrees.

The claimed configurations describe a very compact and light-weight device. Sanders proposes a device that is at least double the size of the claimed device. Sanders also illustrates a mounting bracket at the top of the back plate of the device that apparently is used to help support the body of the device in position in the socket. This teaches away from the claimed light-weight and compact device as claimed. The claimed sizes refer to a relatively thin compact device that covers a single plug-in socket to allow the other socket to be used for other connections without blocking it from use. As such, the claimed configuration is not a matter of mere change in size. Applicant respectfully submits that Claims 16-19 and 31 are independently patentable over the cited art.

III. Legal Support of Patentability

The fact that the invention employs known elements does not preclude patentability. It is the claimed combination of elements which is the proper basis for review. "Virtually all inventions are necessarily combinations of old elements." *Panduit* at 1575 (citing *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 220 USPQ 97, 99-100 (Fed. Cir. 1983)). Indeed, the Federal Circuit has stated (in regard to an obviousness-type invalidity challenge to an issued patent) that "[t]he notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, §103." *Panduit* at 1575.

As affirmed by the Court of Appeals for the Federal Circuit, to support combining references in a §103 rejection, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement is not met by merely offering broad, conclusory statements about teachings of references. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Further, "[i]t is insufficient to establish obviousness that the separate

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elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements.” *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997) (emphasis added). The standard of obviousness is not whether, in hindsight, someone would have combined elements to form the invention. *W.L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 312-313 (Fed. Cir. 1983). Further, simplicity alone cannot be determinative of obviousness. *Gentry Gallery, Inc. v. Berkline Corp.*, 45 USPQ2d 1498 (Fed. Cir. 1998).

Applicants respectfully submit that the Action selects discrete features from different prior art documents without considering the references overall teaching and selectively combines them to reject the pending claims. Applicants submit that the Action is using impermissible hindsight rationale to select the different features from the prior art documents without considering the teachings of the documents in whole. The question of patentability does not rest on whether discrete features are found in different prior art documents (or, indeed, on the simplicity of the invention). Rather, it is the claimed combination that is the proper focus of the inquiry.

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IV. Conclusion

Accordingly, Applicant submits that the present application is in condition for allowance and the same is earnestly solicited. Should the Examiner have any matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

Respectfully submitted,

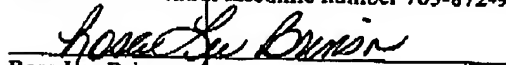


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